

REMARKS

This Response is submitted in reply to the Office Action dated August 18, 2010. No claims have been amended. Claims 1 to 53, 55, 59, 62 and 70 were previously cancelled. Please charge deposit account number 02-1818 for any fees associated with this Response.

The Office Action rejected Claims 54, 56 to 58, 60, 61, 63, 65 to 69 and 71 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,146,273 to Olsen ("Olsen '273") in view of U.S. Patent No. 5,467,856 to Okada.

As stated in the Responses to Office Action dated February 3, 2010 and June 7, 2010 and reiterated herein, Applicant respectfully submits that Olsen '273 does not qualify as prior art to at least Claims 54, 56, 57, 60, 61, 63 and 65 to 69 for at least the following reasons.

Under a first interpretation, the Office Action appears to interpret the last value symbol selected in the play of the bonus game illustrated in Figure 13 of Olsen '273 and described in column 8, lines 26 to 34, column 24, lines 1 to 39 and column 30, line 31 to column 31, line 27 of Olsen '273 as the end game symbols of the methods of operating a gaming machine of Claims 54, 56, 57, 60, 61, 63 and 65 to 69.

Under a second, alternative interpretation, the Office Action appears to interpret the null symbols which adjust the bonus mode length as described in column 24, lines 40 to 44 and column 30, line 31 to column 31, line 27 of Olsen '273 as the end game symbols of the methods of operating a gaming machine of Claims 54, 56, 57, 60, 61, 63 and 65 to 69.

The Office Action further interprets the bonus game illustrated in Figure 13 of Olsen '273 and described in column 24, lines 12 to 17 and column 30, line 31 to column 31, line 27 of Olsen '273 as: (i) the displayed individual numerical award values associated with the randomly generated award value symbols and (ii) the summing of the individual displayed numerical award values associated with any displayed award value symbols to form an accumulated winnings value, of the methods of operating a gaming machine of Claims 54, 56, 57, 60, 61, 63 and 65 to 69.

The effective date for Olsen '273 is the filing date of March 30, 1998. Specifically, as Olsen '273 is a continuation-in-part patent application of U.S. Patent No. 6,110,043 ("Olsen '043"). The subject matter illustrated in Figure 13 of Olsen '273 and described in column 24, lines 1 to 44 and column 30, line 31 to column 31, line 27 of Olsen '273 was not described in Olsen '043.

Thus, the effective date of such subject matter from Olsen '273 is March 30, 1998, not October 24, 1997.

The present patent application is a continuation patent application of U.S. Patent Application No. 10/161,498, filed on June 3, 2002, which issued as U.S. Patent No. 6,648,759, which is a continuation patent application of U.S. Patent Application No. 09/540,259, filed on March 31, 2000, which issued as U.S. Patent No. 6,398,218, which is a continuation patent application of U.S. Patent Application No. 09/346,210, filed on July 1, 1999, which issued as U.S. Patent No. 6,059,289, which is a continuation patent application of U.S. Patent Application No. 09/260,634, filed on March 2, 1999, which issued as U.S. Patent No. 6,033,307, which claims priority to Provisional Patent Application No. 60/077,042, filed on March 6, 1998 and Provisional Patent Application No. 60/077,511, filed on March 11, 1998.

Applicant submits that each and every element of at least Claims 54, 56, 57, 60, 61, 63 and 65 to 69 are supported by both Provisional Patent Application No. 60/077,042, filed on March 6, 1998 and Provisional Patent Application No. 60/077,511, filed on March 11, 1998.

Thus, the effective date for at least Claims 54, 56, 57, 60, 61, 63 and 65 to 69 is March 6, 1998.

Accordingly, Applicant respectfully submits that Olsen '273 is not prior art to at least Claims 54, 56, 57, 60, 61, 63 and 65 to 69.

If the Examiner disagrees with Applicant, to expedite prosecution of the present application, Applicant welcomes the Examiner to point out, using specific columns, lines and figures, where the subject matter illustrated in Figure 13 of Olsen '273 and described in column 24, lines 1 to 44 and column 30, line 31 to column 31, line 27 of Olsen '273 are described in Olsen '043

Since Olsen '273 is not prior art to at least Claims 54, 56, 57, 60, 61, 63 and 65 to 69, Applicant turns to Okada.

Okada discloses a slot machine having a coin sensor, which is connected to a CPU via a signal line, and generates a coin-detecting signal upon insertion of a coin. The slot machine of Okada stands by for execution of a game in response to the coin insertion, under the control of the CPU. A reel-stop switch is connected to the CPU via a signal line, and generates a reel-stop signal in response to a button depression. A test signal generator of Okada outputs a test signal to the signal line of the reel-stop switch. The CPU checks the signal line of the coin sensor. If the test signal is detected through the signal line of the coin sensor, execution of the game is inhibited, whereby a fraudulent operation is detected.

Specifically, column 1, lines 25 to 36 of Okada discloses:

[t]he CPU in response to the start signal starts rotating the three reels simultaneously. Stop buttons are next depressed, to generate a reel-stop signal at a High level. The CPU controls a reel control circuit to stop the reels. If symbols are stopped along a winning line, namely a line defined horizontally or diagonally across the reels, in a combination predetermined as winning, then the CPU causes a coin dispenser to pay out coins of a number associated with the winning grade of the symbol combination, to end one game. If symbols are stopped not in a winning combination, the game ends in a loss.

While Okada may include generating a combination of symbols, Applicant respectfully submits that Okada does not anticipate or render obvious (without the benefit of improper hindsight reconstruction): (a) randomly generating a combination of game symbols from a plurality of game symbols, the plurality of game symbols at least including a plurality of different award value game symbols and a plurality of end game symbols, the end game symbols being predetermined prior to any random generation of the combination of game symbols, (b) causing a display of the gaming machine to display, for each of any randomly generated award value game symbols of the randomly generated combination of game symbols, an individual numerical award value associated

with the randomly generated award value game symbol, (c) summing the individual displayed numerical award values associated with any displayed award value game symbols to form an accumulated winnings value, (d) repeating steps (a) and (c) until a predetermined number of the end game symbols have been randomly generated in the generated combinations of game symbols, the predetermined number being at least one, and (e) ending play when the predetermined number is reached.

On the other hand, the method of operating a gaming machine of independent Claim 54 includes (a) randomly generating a combination of game symbols from a plurality of game symbols, the plurality of game symbols at least including a plurality of different award value game symbols and a plurality of end game symbols, the end game symbols being predetermined prior to any random generation of the combination of game symbols, (b) causing a display of the gaming machine to display, for each of any randomly generated award value game symbols of the randomly generated combination of game symbols, an individual numerical award value associated with the randomly generated award value game symbol, (c) summing the individual displayed numerical award values associated with any displayed award value game symbols to form an accumulated winnings value, (d) repeating steps (a) and (c) until a predetermined number of the end game symbols have been randomly generated in the generated combinations of game symbols, the predetermined number being at least one, and (e) ending play when the predetermined number is reached.

For at least these reasons, Applicant submits that Claim 54 is patentably distinguished over Okada and is condition for allowance.

Claims 56 to 58, 60 and 61 depend directly from independent Claim 54 and are also allowable for the reasons given with respect to independent Claim 54 and because of the additional features recited in these claims.

Independent Claims 63, 67 and 69 each include certain elements similar to certain elements of independent Claim 54. For reasons similar to the reasoning discussed above with respect to independent Claim 54, independent

Claims 63, 67 and 69 (and dependent Claims 65, 66, 68 and 71) are each patentably distinguished over Okada and are in condition for allowance.

For purposes of expediting prosecution of the present application, Applicant will assume, *arguendo*, that Olsen '273 is prior art to Claims 54, 56, 57, 60, 61, 63 and 65 to 69.

Olsen '273 discloses a method of operating of controller-based progressive gaming system having a plurality of gaming machines wherein each gaming machine generates unit bet information indicative of a number of unit bets supplied to a machine for playing a game. The method of Olsen '273 includes randomly selecting a bonus mode activation value between a high and low limit, providing a current value, providing a base value, incrementing the current value when the gaming machines are played so that the current value is incremented by a fixed amount of each unit bet received by each gaming machine. A bonus mode time period of Olsen '273 is entered when the incremented current value is equal to or exceeds the bonus value. Eligible machines are locked-in and random bonus jackpots are made during the bonus time period. Each bonus award decrements the current value by the amount of each award and the bonus mode time period is ended when the current value is less than or equal to the base value.

The Office Action stated that:

the examiner interprets the teaching of Olsen as teaching an end game symbol when the last value symbol is selected. Because as claimed by Olsen, the game ends when the current value of the bonus game equals or drops below zero, therefore the symbol selected before this occurs can be interpreted as the end game symbol for the bonus mode. ... Further the null symbol produces a zero value outcome which according to col. 8 has the ability to end the bonus mode.

The Office acknowledged that:

Olsen does not explicitly mention said end game symbols being predetermined prior to any random generation of the combination of game symbols.

The Office Action continued that:

Okada explicitly teaches symbols stopped along a specific line that based on a predetermined combination of symbols, function as end game symbols because the game to end and if the combination are winning combinations the winning outcome is achieved, which examiner believes to teach the limitation of said end game symbols being predetermined prior to symbol generation (see col. 1, lines 29-35).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Okada into the teachings of Olsen. One would be motivated to do this so as to have symbols that have been decided ahead that would cause the game to end thereby according to Okada preventing fraudulent activities, and making the game more enjoyable and secure for the game player.

Applicant submits that under a first interpretation, it appears that the Office Action is interpreting: (i) the symbol selected which causes the current value of the bonus pool to be equal to or less than zero (which ends the bonus mode time period) in Olsen '273, and (ii) the symbols which are not part of a winning symbol combination of Okada as the end game symbol being predetermined prior to any random generation of the combination of game symbols of the method of operating a gaming machine of Claim 54.

Under this first interpretation, Applicant submits that modifying Olsen '273 with Okada changes the principal operation of Olsen '273 and results in Olsen '273 being unsatisfactory for its intended purpose. The law is clear that if a proposed modification would render the prior art unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See for instance *In re Gordon*, 733 F.2d 900, (Fed. Cir. 1984).

To establish a *prima facie* case of obviousness, the Examiner has an obligation to construe the scope of the prior art, identify the differences between the claims and the prior art, and determine the level of skill in the pertinent art at the time of the invention. The Examiner must then provide: (1) an explicit, cogent reason based on the foregoing why it would be obvious to modify the prior art to arrive at the claimed invention; (2) a reasonable expectation of success; and (3)

a teaching or suggestion of all claimed features. See MPEP. §§ 706.02(j) and 2143.

When Olsen '273 is modified such that the symbol selected which causes the current value of the bonus pool to be equal to or less than zero (which ends the bonus mode time period) is predetermined prior to any random generation of game symbols, Olsen '273 ceases to properly function in its intended manner. The selected symbol in Olsen '273 which causes the bonus pool to decrement to zero is unknown prior to the bonus mode time period of Olsen '273. That is, the bonus pool of Olsen '273 decrements to zero based on one or more events which occur during the bonus mode time period and which specific symbol will be selected to end the bonus mode time period is not known prior to the occurrence of these events. As described in column 24, lines 1 to 39 and column 30, line 31 to column 31, line 27 of Olsen '273 (i.e., the relied on portion of Olsen '273), the values provided to the player during the bonus mode time period are the matched values. As which values will be matched in which order is unknown and the matched values decrement the bonus pool, the last matched value which causes the bonus pool to decrement to zero (i.e., the interpreted end game symbol) is also unknown. For example, under the Office Action's interpretation, if a first matched value of \$75 causes the bonus pool of Olsen '273 to decrement to zero, the \$75 is the interpreted end game symbol. In another example, if a second matched value of \$50 causes the bonus pool of Olsen '273 to decrement to zero, the \$50 is the interpreted end game symbol. As Olsen repeatedly discloses that which value causes the bonus pool to decrement to zero is based on which matches occur and is unknown prior to the beginning of the bonus mode time period, Applicant respectfully submits that modifying Olsen '273 such that the specific symbol selected to end the bonus mode time period is predetermined prior to any random generation of game symbols would destroy the intended functionality of Olsen '273. Accordingly, under this first interpretation of Olsen '273, the combination of Olsen '273 with Okada is improper and this rejection premised on this improper combination is also improper and should be withdrawn.

Under a second, alternative interpretation, the Office Action appears to interpret: (i) the null symbols which adjust the bonus mode length of Olsen '273 and (ii) the symbols which are not part of a winning symbol combination of Okada as the end game symbols of the method of operating a gaming machine of Claim 54. Based on this interpretation, Applicant respectfully submits that the null symbols of Olsen '273 adjust the bonus mode length and the average number of games played in the bonus mode, but such null symbols do not end the bonus mode time period of Olsen '273. That is, such null symbols only appear to delay or prolong the bonus mode time period of Olsen '273. In other words, Olsen '273 does not anticipate ending play when the predetermined number of the end game symbols have been randomly generated in the generated combinations of game symbols, the predetermined number being at least one.

Okada does not cure this deficiency of Olsen '273.

Accordingly, unlike the method of operating a gaming machine of independent Claim 54, the combination of Olsen '273 and Okada does not anticipate or render obvious (without the benefit of improper hindsight reconstruction) ending play when the predetermined number of the end game symbols have been randomly generated in the generated combinations of game symbols, the predetermined number being at least one.

For at least these reasons, Applicant respectfully submits that independent Claim 54 is patentably distinguished over Olsen '273 in view of Okada and is in condition for allowance.

Claims 56 to 58, 60 and 61 depend directly from independent Claim 54 and are also allowable for the reasons given with respect to independent Claim 54 and because of the additional features recited in these claims.

Independent Claims 63, 67 and 69 each include certain elements similar to certain elements of independent Claim 54. For reasons similar to the reasoning discussed above with respect to independent Claim 54, independent Claims 63, 67 and 69 (and dependent Claims 65, 66, 68 and 71) are each patentably distinguished over Olsen '273 in view of Okada and are in condition for allowance.

The Office Action rejected Claims 64 and 72 under 35 U.S.C. §103(a) as being unpatentable over Olsen '273 in view of Okada and further in view of U.S. Patent No. 6,234,897 to Frohm et al. ("Frohm").

Applicant submits that each and every element of at least Claims 64 and 72 are supported by both Provisional Patent Application No. 60/077,042, filed on March 6, 1998 and Provisional Patent Application No. 60/077,511, filed on March 11, 1998.

Thus, the effective date for at least Claims 64 and 72 is March 6, 1998.

As described above, the effective date for Olsen '273 is the filing date of March 30, 1998.

Accordingly, Applicant respectfully submits that Olsen '273 is not prior art to Claims 64 and 72.

Regarding Frohm, column 1, lines 56 to 62 of the background of the invention of Frohm discloses:

[t]he bonus game is entered upon the appearance of a special symbol combination of start-bonus symbols on the reels of the slot machine in the base game. In the bonus game, the probability of winning combinations appearing on the reels, or the "hit rate," is much greater than that of the base game. The player is permitted to keep playing and accumulate winnings from the bonus game until a losing trial occurs.

Column 2, lines 13 to 24 of the summary of the invention of Frohm discloses:

[a] slot machine comprises a spinning reel display and a bonus game. The spinning reel display shows a plurality of symbols on each of a plurality of rotatable reels. The reels are rotated and stopped to place the symbols of each reel in visual association with a pay line. The pay line is associated with at least one of the symbols on each of the reels. The bonus game is triggered in response to start-bonus symbols from the respective stopped reels appearing in the spinning reel display. The bonus game having different expected values based on different arrangements of the start-bonus symbols in the spinning reel display.

As described in the Response to Office Action dated September 8, 2009 and reiterated herein, Applicant submits that, unlike the method of operating a gaming machine of Claim 64, Frohm does not anticipate randomly generating a combination of a plurality of game symbols, the plurality of game symbols at least including a plurality of different award value game symbols and at least one end game symbol.

As also described in the Response to Office Action dated September 8, 2009 and reiterated herein, Applicant submits that, unlike the method of operating a gaming machine of Claim 64, Frohm does not anticipate summing the individual displayed numerical award values to form an accumulated winnings value.

As further described in the Response to Office Action dated September 8, 2009 and reiterated herein, Applicant submits that, unlike the method of operating a gaming machine of Claim 64, Frohm does not individual symbols that end the play of the bonus game.

Okada does not cure these deficiencies of Frohm.

Accordingly, unlike the method of operating a gaming machine of Claim 64, the combination of Okada and Frohm does not anticipate or render obvious (without the benefit of improper hindsight reconstruction) randomly generating a combination of game symbols from a plurality of game symbols for a play of a bonus game, the plurality of game symbols at least including a plurality of different award value game symbols and at least one end game symbol, for the play of the bonus game, summing the individual displayed numerical award values associated with any randomly generated award value game symbols to form an accumulated winnings value, and ending the play of the bonus game when either one of: (i) the formed accumulated winnings value reaches a predetermined value greater than zero, or (ii) at least one of the end game symbols is randomly generated in at least one of the randomly generated combinations of game symbols.

For at least these reasons, Applicant submits that Claim 64 is patentably distinguished over Okada in view of Frohm and is condition for allowance.

Claim 72 includes certain elements similar to certain elements of Claim 64. For reasons similar to the reasoning discussed above with respect to Claim 64, Claim 72 is patentably distinguished both Okada in view of Frohm and is in condition for allowance.

For purposes of expediting prosecution of the present application, Applicant will assume, *arguendo*, that Olsen '273 is prior art to Claims 64 and 72.

If the Office Action is relying on the first interpretation of Olsen '273 (i.e., the symbol selected which causes the current value of the bonus pool to be equal to or less than zero in Olsen '273 is interpreted as the end game symbol of the method of operating a gaming machine of Claim 64), then Applicant submits that as described above, Olsen '273 cannot be properly combined with Okada. Accordingly, any rejection premised on this improper combination is also improper and should be withdrawn.

Alternatively, if the Office Action is relying on the second interpretation of Olsen '273 (i.e., the null symbols which adjust the bonus mode length of Olsen '273 are interpreted as the end game symbols of the method of operating a gaming machine of Claim 64), then Applicant submits that, as described above, Olsen '273 does not anticipate ending play when the predetermined number of the end game symbols have been randomly generated in the generated combinations of game symbols, the predetermined number being at least one.

Neither Okada nor Frohm cure this deficiency of Olsen '273.

Accordingly, unlike the method of operating a gaming machine of Claim 64, the combination of Olsen '273, Okada and Frohm does not anticipate or render obvious (without the benefit of improper hindsight reconstruction) ending play when the predetermined number of the end game symbols have been randomly generated in the generated combinations of game symbols, the predetermined number being at least one.

For at least these reasons, Applicant submits that Claim 64 is patentably distinguished over Olsen '273, Okada and Frohm and is condition for allowance.

Claim 72 includes certain elements similar to certain elements of Claim 64. For reasons similar to the reasoning discussed above with respect to Claim 64, Claim 72 is patentably distinguished Olsen '273, Okada and Frohm and is in condition for allowance.

An earnest endeavor has been made to place this application in condition for allowance and is courteously solicited. If the Examiner has any questions related to this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

K&L Gates LLP

BY



Adam H. Masia
Reg. No. 35,602
Customer No. 29159
(312) 807-4284

Dated: October 12, 2010